UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,656	11/21/2003	Alfonso O. Lopez	014208.1637 (93-03-022)	2376

35005 7590 10/28/2009

BAKER BOTTS L.L.P.
2001 ROSS AVENUE, 6TH FLOOR
DALLAS, TX 75201-2980

EXAMINER	
STRODER, CARRIE A	

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
10/28/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com
PTOmail4@bakerbotts.com

Office Action Summary	Application No.	Applicant(s)	
	10/719,656	LOPEZ ET AL.	
	Examiner	Art Unit	
	CARRIE A. STRODER	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on 06 July 2009, wherein:

Claims 1-3 and 4-14 are currently pending; and

claim 4 is currently cancelled.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-3 and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruffin et al. (US 6249769), in view of Chan et al. (US 20050021348).**

Referring to claim 1:

Ruffin teaches

receiving a business solution (col. 6, lines 6-20; "the representative will engage a potential customer or customers…and describe the preferred solution");

categorizing, by a processor, the business solution into a solution type (col. 6, lines 6-20; "attempt to discern an appropriate customer set" inherently requires categorizing the solution); and

mapping, by a processor, a plurality of standards used by the business solution (col. 6, lines 6-20; "it is…determined whether the proffered solution matches the customers' IT requirements").

Ruffin does not teach; however, Chan teaches

creating, by a processor, a logical technology architecture used to implement the business solution, wherein creating the logical technology architecture used to implement the business solution comprises generalizing a plurality of technology products used to implement the business solution, and wherein generalizing the technology products comprises categorizing the

technology products into logical technology components (paragraphs 158 and 454; "…the system categorizes the technology objects in the categories of interface, control, and entity objects…").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Ruffin as taught by Chan because this would provide a manner in which to offer solutions not limited to a particular brand, allowing for additional flexibility to meet the customers' needs.

Referring to claim 2:

Ruffin teaches

adding a workable solution based on the business solution (col. 6, lines 6-20; "the provider and customer engage in an ad-hoc series of planning and implementation steps"); and

mapping multiple ones of the technology products used in the workable solution (col. 6, lines 6-20; "it is…determined whether the proffered solution matches the customers' IT requirements" and where the proffered solution is interpreted to include a multiple technology products).

Referring to claim 3:

Ruffin does not teach; however, Chan teaches wherein the logical technology architecture, the solution type, the

plurality of standards, the workable solution, and the plurality of technology products encompass a reference solution architecture that provides a reusable solution that is implementable with different sets of technology products (paragraph 158).

Further, no positive step is recited; therefore, the limitation receives little patentable weight.

Referring to claim 5:

Ruffin teaches wherein categorizing the business solution into the solution type comprises categorizing the business solution according to an industry in which the business solution has been applied (col. 9, lines 8-19; "proceeds to select target customers aligned with the various organized solutions offerings…the determination of whether a particular customer aligns with a proffered solution may be based upon the type of industry in which the customer does business").

Referring to claim 6:

Ruffin teaches wherein categorizing the business solution into the solution type comprises categorizing the business solution according to a business domain in which 5 the business solution has been applied (col. 9, lines 8-19; wherein "type of industry" is interpreted as "business domain").

Referring to claim 7:

Ruffin teaches wherein the plurality of standards used by the business solution comprise at least one of industry standards, industry application framework, application architecture design principle, design patterns and application programming interface (col. 6, lines 6-20 "customers' IT requirements" and col. 13, line 36 thru col. 14, line 27 "operating system software").

Referring to claim 8:

Ruffin teaches

a memory comprising a reference solution architect (col. 8, lines 9-35);

a processor, wherein the reference solution architect is executable on the processor (col. 7, line 59 thru col. 8, line 5; where "computer program" implies the use of a processor to run said program);

receive a business solution (col. 6, lines 6-20; "the representative will engage a potential customer or customers…and describe the preferred solution");

categorize the business solution into a solution type (col. 6, lines 6-20; "attempt to discern an appropriate customer set" inherently requires categorizing the solution); and

map a plurality of standards used by the business solution (col. 6, lines 6-20; "it is…determined whether the proffered solution matches the customers' IT requirements").

Ruffin does not teach; however, Chan teaches

create a logical technology architecture used to implement the business solution, wherein the logical technology architecture provides a clustering of technologies into logical technology components to allow policies and strategies to be assigned to the logical technology components, wherein each logical technology component is a logical group of physical elements having a common technical characteristic (paragraphs 559-560; "these templates can be drawn into the creation and evaluation of alternative solution development proposals").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Ruffin as taught by Chan because this would provide a manner in which to offer solutions not limited to a particular brand, allowing for additional flexibility to meet the customers' needs.

Referring to claims 9 and 12-14:

Claims 9 and 12-14 are the system claims associated with the method of claims 2 and 5-7, respectively; therefore, they are rejected on the same basis as claims 2 and 5-7.

Referring to claim 10:

Ruffin teaches further comprising a database operable to store the logical technology architecture, the solution type, the plurality of standards, the workable solution and the plurality of technology products as a reference solution architecture that provides a reusable solution that is implementable with different sets of technology products (col. 7, lines 59-65).

Furthermore, storing the logical technology architecture, the solution type, the plurality of standards, the workable solution and the plurality of technology products as a reference solution architecture that is implementable with different sets of technology products in a database are non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S.

175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the act of storing the logical technology architecture, the solution type, the plurality of standards, the workable solution and the plurality of technology products as a reference solution architecture, can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are

performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 11:

Ruffin does not teach; however, Chan teaches

Wherein the logical technology architecture used to implement the business solution, wherein creating the logical technology architecture used to implement the business solution and wherein generalizing the technology products comprises categorizing the technology products into logical technology components (paragraphs 158 and 454; "…the system categorizes the technology objects in the categories of interface, control, and entity objects…").

Response to Arguments

1. Applicant's arguments with respect to claims 1 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Bhaskaran et al. (US 20050080640).

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689